

**REMARKS**

Applicant gratefully acknowledges the courtesy of a personal interview on May 10, 2004, in which Examiner Kramer and Minh-Quan K. Pham discussed several issues in respect to the pending application. During the interview, the Sergeant reference was discussed with regard to the claims. It was agreed that specifying the ends opposite the apex of the to be unconnected free ends would overcome the Sergeant reference. Pursuant to the interview, Applicant files a Request for Continued Examination (RCE) herewith. The present amendment is intended as a submission required under 37 C.F.R. § 1.114 and is submitted concurrently with the RCE.

The Final Office Action mailed July 21, 2003, has been carefully considered. The present Amendment is intended to be a complete response thereto and to place the case in condition for allowance.

Claims 11-27 are pending. Claims 1-10 have been cancelled without prejudice to the subject matter therein. Claims 11, 14-17, and 19-26 have been amended. Claims 11 and 22-25 have been amended to specify that the second ends of the legs are unconnected. Support for the amendment is found, *inter alia*, in Fig. 1. Claims 14-17, 19-21, and 26 have been amended to use consistent language with respect to their independent claims. Claim 26 have also been amended to depend from claim 11 instead of cancelled claim 1. Claim 27 have been added. Support for claim 27 is found, *inter alia*, in Figs. 1-5.

## THE CLAIMS ARE NOT INDEFINITE

Claim 26 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because the claim depends from cancelled claim 1. Claim 26 have been amended to depend from pending claim 11. Therefore, proper dependency has been established. Withdrawal of the rejection is respectfully solicited.

## THE CLAIMS ARE NOT OBVIOUS

Claims 11-16 and 22-26 stand rejected under 35 U.S.C §103(a) as being obvious over Sergeant (U.S. Patent No. 4,387,610) in view of Kaufman (U.S. Patent No. 5,192,106). Claim 22 stands rejected under 35 U.S.C §103(a) as being obvious over Seyfriedt (U.S. Patent No. 533,923) in view of Kaufman. Claim 23 stand rejected under 35 U.S.C §103(a) as being obvious over Seyfriedt in view of Kaufman, and further in view of GB 2 035 187 (GB '187). Applicant respectfully traverses the rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP 2143.

With regard to the rejection of claims 11-16 and 22-25 over Sergeant in view of Kaufman, the references, taken alone or in combination, fail to disclose every element of the

invention as claimed. Neither Sergeant nor Kaufman disclose a pair of tweezers 1) having legs with connected first ends and unconnected second ends that are capable of reversible engagement; or 2) that are made of “light metal profile by extrusion and by separation of said profile approximately transversely to said direction of extrusion.”

Sergeant discloses a “force applying tool” which has no “legs” that are unconnected second ends. The tool of Sergeant operates as a ram so that when manual pressure is exerted to the sides 12 and 14, the movable end or “jaw” 4 is forced into the fixed jaw 2. This tool has nothing in common with a pair of tweezers. Thus, contrary to the Examiner’s assertion, Sergeant fails to disclose a pair of tweezers altogether.

Even as alleged by the Examiner where the sides 12 and 14 and the cords 16 and 18, together, form “legs,” the ends 16B and 18B are not unconnected. These ends are permanently connected to each other by being permanently attached to the jaw 4. The parts of Sergeant’s tool that actually come into reversible engagement are the cords connecting the ends 16B and 18B to opposed ends 16A and 18A. Those cords cannot be considered ends because they are not located at the termination of the legs. If one compares FIGS. 1 and 2 where the ends 16B and 18B are in engagement in both figures and are never released from each other. Thus, these ends (16B and 18B) are permanently connected, which is in apposite to the present invention which requires the second ends to be unconnected.

As admitted by the Examiner, Sergeant fails to disclose that the tool is formed of “light metal.” As a matter of fact, Sergeant specifically discloses that the tool is “of unitary, molded or extruded, plastic construction, which eliminates assembly linkages and other separate parts” (see

column 1, lines 28-30). Nevertheless, the Examiner avers that Kaufman teaches the use of “light metal” to make tweezers. The present invention, however, recites that the tweezers be formed of “light metal profile by extrusion and by separation of said profile approximately transversely to said direction of extrusion” (see claim 11). Although in column 3, lines 62-66, Kaufman discloses the spring steel and aluminum for making his tongs, the reference fails to disclose that it is made “by extrusion and by separation of said profile approximately transversely to said direction of extrusion.”

Further, there is no motivation to combine the references. First, the tools of Sergeant and of Kaufman are completely different and one of ordinary skill in the art would not have been motivated to combine the teachings of the references. Second, Sergeant requires that the tool be made out of “plastic … which eliminates assembly linkages and other separate parts” (see column 1, lines 28-30). Thus, because Sergeant taught a specific advantage to using plastic, as opposed to other materials, constructing the tool of Sergeant from metal would have been contrary to the teaching of Sergeant. It is well known that a proposed modification cannot render the prior art unsatisfactory for its intended purpose. *See MPEP 2143.01.*

Furthermore, in effect, Sergeant teaches that if his tool is made out of materials other than plastic, such as light metal, it would have required separate parts and assembly linkages. The present invention seeks to solve the problem articulated by Sergeant, i.e. making a pair of tweezers out of light metal without requiring separate parts and linkages. The present inventor recognizes that a pair tweezers can be made out of light metal without the disadvantages

disclosed by Sergeant by practicing the present invention. Therefore, the present invention is unexpected result that has been discounted by Sergeant.

Moreover, Kaufman discloses a variety of materials other than spring steel or aluminum to form his tongs, including plastic, carbon fiber/Kevlar, epoxy, glass reinforce thermoplastic, and injection molded polycarbonate. For the sake of argument, even if one of ordinary skill in the art improperly combines the teachings of Sergeant and Kaufman, the resulting combination would be made of plastic, not metal, because both references teach forming their respective devices of plastic, while only Kaufman suggest the use of spring steel or aluminum. There is no motivation to choose metals over plastics because both references clearly prefer plastic. Kaufman specifically prefers molded polycarbonate over other disclosed materials (see column 3, lines 62-66). Sergeant also prefers plastic (see column 1, lines 28-30). Therefore, the combination of the references would have produced a plastic device rather than a metal device.

With regard to the rejection of claim 22 over either Seyfriedt in view of Kaufman, the references, taken alone or in combination, fails to disclose every element of the invention as claimed. In particular, neither Seyfriedt nor Kaufman discloses that the leg ends are “capable of being brought into reversible engagement with each other at their second ends by manual exertion of a closure pressure of at least about 150 g” as required by claim 22. Nevertheless, the Examiner alleges that such a closure pressure is obvious “in order for easy manual manipulation.” Applicant respectfully asserts that the Examiner’s allegation is incorrect. First, the Examiner has not given a clear motivation for selecting a closure pressure of about 150 g and not more or less. If one of ordinary skill in the art is motivated to have a closure pressure for

“easy manual manipulation” as alleged by the Examiner, he/she would have selected a very low pressure of 50 g or less and not 150 g. The Examiner appears to have misunderstood the significance of such closing pressures. It is very easy to make tweezers of any material and shape if a low closure pressure would suffice. In fact, light metal tweezers capable of replacing steel tweezers (which have closure pressure of above 100 grams) require such a relatively high closure pressure that, prior to the present invention, it is anything but obvious to achieve. The present invention provides tweezers made out of light metals that have the same closure pressure as those made of steel. This is clearly unexpected over the prior art. Therefore, there is no motivation to modify the cited references to arrive at the present invention.

With regard to the rejection of claim 23 over Seyfriedt in view of GB ‘187, the references, taken alone or in combination, fail to disclose every element of the invention as claimed. Seyfriedt, as discussed above, fails to disclose a closing pressure of about 150 g. The Examiner relies on GB ‘187 to show “a pair of tweezers having a bulge or projection (16a and 16b) extending inwardly from each leg so as to limit deformation of the tweezers upon manual compression thereof.” However, because Seyfriedt is deficient in disclosing the closing pressure of about 150 g, this deficiency is not satisfied by GB ‘187. Accordingly, Seyfriedt in view of GB ‘187 do not render claim 23 obvious.

For the reasons cited, the Examiner has not made a *prima facie* case of obviousness because the references, taken alone or in combination, fail to disclose every element of the presently claimed invention and because there is no motivation to combine the references.

Therefore, the claims are not obvious under the meaning of 35 U.S.C §103(a). Reconsideration and withdrawal of the rejection are respectfully requested.

Applicant has advanced extensive arguments and reasons for inappropriate combination of the references in the Response to Non-Final Office Action filed October 21, 2003, which include evidence of unexpected results (again presented herein). However, none of these arguments are addressed by the Examiner in the Final Office Action. Applicant respectfully requests that the Examiner address each argument presented by Applicant so that the Examiner's position is complete and clear pursuant to 37 C.F.R. 1.104. Further, please note that Examiner Note 1 of Form Paragraph 7.37 specifically states that “[t]he examiner must address all arguments which have not already been responded to in the statement of the rejection.” *See* MPEP 707.07. In this case, the Examiner addresses Applicant's argument neither in the statement of the rejection nor elsewhere in the Final Office Action. To that end, Applicant respectfully requests issuance of an Office Action addressing Applicant's arguments.

#### **ALLOWABLE SUBJECT MATTER**

Applicant gratefully acknowledges the Examiner's indication that claims 17-21 would be allowable if rewritten to include all the limitations of the base claim and any intervening claims.

#### **CONCLUSION**

Applicant has responded to the Final Office Action mailed December 11, 2003. A Petition for a one-moth extension, a Request for Continued Examination (RCE), and fees

therefore are filed herewith. All pending claims are now believed to be allowable and favorable action is respectfully requested.

In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (000364-00123). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, applicant hereby petitions under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to render this submission timely.

Any fees due are authorized above.

Respectfully submitted,

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